IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
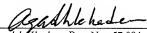
Applicant	:	Michael A. Wilkman	

App. No	:	09/909,194
Filed	:	July 19, 2001
For	:	UNIVERSAL TRANSACTION MANAGER AGENT, SYSTEMS AND METHODS
Examiner	:	Donald Champagne
Art Unit	:	3622

PRE-APPEAL BRIEF

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully requests review of the final rejection mailed February 25, 2008 in the above-identified application. No amendments are being filed with this request. Enclosed with this Request is a Notice of Appeal. The review is requested for the reasons stated below:

The Examiner has rejected Claims 8-11 and 19 under 35 U.S.C. § 102(e) a as being anticipated by United States Patent No. 6,915,271 to Meyer et al. (hereinafter "Meyer"), has rejected Claims 1, 4, 5, 12, 13 and 15 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,397,198 to Hoffman et al. (hereinafter "Hoffman"), and has also rejected Claims 2, 3, 6, and 24-27 under 35 U.S.C. § 103(a) as being unpatentable over Hoffman in view of Meyer. However, the Examiner has failed to show the essential elements needed to establish a prima facie case of both anticipation and obviousness.

Rejection of Claims 8-11 and 19 under 35 U.S.C. § 102(e)

The Examiner contends that Meyer teaches all elements of Claims 8-11 and 19. Applicant respectfully traverses this rejection, as discussed below.

Claim 8

Claim 8, recites, among other things, "matching at least one of the plurality of promotions to at least one of the plurality of users based at least upon a portion of the plurality of user

information and *the user payment account information*." Emphasis added. Meyer fails to disclose at least these limitations of Claim 8. Meyer teaches that in some instances an incentive requires membership in an external membership organization which can be a credit card company sponsoring the promotion. *Id.* at Col. 17, ll. 20-27; Col. 24, ll. 1-8. In Meyer, **the user is presented with a variety of incentives from which the user can select**. If the user selects an incentive which is restricted to holders of a particular credit card, then the system verifies whether or not the user qualifies for the incentive **by requesting that the user input his/her credit card information**. *Id.* at Col. 32, l. 47 – Col. 33, l. 26. In Claim 8, however, the method first matches "at least one of the plurality of promotions to at least one of the plurality of users based at least upon a portion of the plurality of user information and *the user payment account information*" and then it presents "the at least one of the plurality of promotions" to the at least one of the plurality of users.

The system of Meyer does not even receive the user's payment account information, until after the user has been presented with a promotion and he/she has selected one that requires a certain payment account. Claim 8 recites receiving "user information relating to a plurality of users, **wherein the user information includes user payment account information;** matching at least one of the plurality of promotions to at least one of the plurality of users based at least upon a portion of the plurality of user information and *the user payment account information,*" and then presenting the at least one of the plurality of promotions to the user.

Meyer also teaches that when initiating a purchase, a user may be presented with a pop-up screen requesting the user's credit card number. The service provider can then use that to charge the purchase. *Id.* at Col. 41, ll. 21-34. This teaching of Meyer merely discloses a method of charging the customer. The credit card number entered is not used for "*matching*" at least one of a plurality of promotions to a user "based upon … *the user payment account information*." Accordingly, Meyer does not teach at least this limitation of Claim 8 and thus Claim 8 is patentably distinguished over Meyer.

Claims 9-11 and 19

Claims 9-11 and 19 depend from Claim 8 and thus include all the limitations of Claim 8, as well as other limitations of particular utility. Applicant respectfully submits that Claims 9-11 and 19 are patentably distinguished over Meyer for the reasons stated above with respect to Claim 8 and because of the additional limitations included in these claims.

Rejection of Claims 1, 4, 5, 12, 13, and 15 under 35 U.S.C. § 103(a)

The Examiner contends that Claims 1, 4, 5, 12, 13, and 15 are obvious in view of Hoffman. Applicant respectfully traverses this rejection, as discussed below.

Claim 1

Claim 1, recites, among other things, "a transaction module configured to present information about the at least one promotion to at least one user ... wherein the promotion relates to preferences that correspond to the user." The Examiner contends that Hoffman teaches this limitation of Claim 1. Applicant respectfully disagrees. Hoffman is directed to a "biometric identification computer system, comprising a database containing registered biometric samples of users" which can be used for user identification during an electronic transaction. Hoffman, Abstract. Hoffman teaches that electronic transactions include loyalty program transactions such as receiving coupons, frequent flyer miles, or free items, using a reward account. Hoffman, Col. 3, l. 63 – Col. 4, l. 2. Hoffman, however, does not teach "**a transaction module configured to present**" information about at least one promotion to at least one user "**wherein the promotion relates to preferences that correspond to the user**," as recited in Claim 1.

Moreover, Claim 1 also recites "the transaction module further configured **to select at least one of the plurality of the user's accounts** to use for a commercial transaction with the at least one of a plurality of merchants wherein the selection is based at least in part on the at least one promotion and **on rules that govern which one of the plurality of the user's accounts should be used.**" Emphasis added. The Examiner agrees that Hoffman does not teach this limitation of Claim 1. Office Action, page 4. The Examiner, however, contends that because Hoffman teaches that the account is selected by the user, "it would have been obvious for the user to make the selection based at least in part on the promotion if there is any benefit in doing so." *Id.* This argument is erroneous, because Claim 1 recites "**the transaction module configured to select** at least one of the plurality of the user's accounts," not the user. The Examiner does not point to any references that teach **a transaction module** selecting a user account based on the promotion and rules that govern which user account should be used to pay for various transactions. Having the transaction module make the selection of the user account based on the promotion and the rules is different from having the user make this selection. The user may not be aware of or have access to all information about the promotion and the rules, as the transaction module does. Moreover, having the transaction module make the selection

results in convenience for the user because the user would not need to review numerous user account agreements and other documents, compare each user account to the promotion, and choose a user account for every transaction. Furthermore, the Examiner has not provided any other reasoning for his assertion that the above cited limitation of Claim 1 would have been obvious in view of Hoffman. Accordingly, the Examiner has failed to establish a prima facie case of obviousness of Claim 1.

Claims 4, 5, 12, 13, and 15

Claims 4, 5, 12, 13, and 15 depend from Claim 1 and thus include all the limitations of Claim 1, as well as other limitations of particular utility. Applicant respectfully submits that these Claims are patentably distinguished over Hoffman for the reasons stated above with respect to Claim 1 and because of the additional limitations included in the claims.

Rejection of Claims 2, 3, 6 and 24-27 under 35 U.S.C. § 103(a)

The Examiner contends that Claims 2, 3, 6 and 24-27 are unpatentable over Hoffman in view of Meyer. Applicant respectfully traverses this rejection, as discussed below.

Claims 2, 3, and 6

Claims 2, 3, and 6 depend from Claim 1 and thus include all the limitations of Claim 1, as well as other limitations of particular utility. As discussed above, Claim 1 is patentably distinguished over Hoffman. Thus, Claims 2, 3, and 6 are also patentably distinguished over Hoffman. In addition, Claims 2, 3, and 6 have other limitations that are not taught in either Hoffman or Meyer. For example, Claim 2 recites a merchant module "configured to: register a plurality of merchants; collect promotion program information; and **track merchant billing information.**" Neither Hoffman nor Meyer teaches these limitations of Claim 2. Thus, Applicant submits that these Claims are not unpatentable over Hoffman in view of Meyer.

Claim 24

Claim 24, recites, among other things, "a transaction manager component configured to manage, via an electronic communications medium, **a user's interests**, the transaction manager component further **configured to select promotions that relate to the user's interests**; and a transaction module **configured to present information about the one or more selected promotions to the user** via an electronic communications medium." The Examiner agrees that Hoffman "does not teach that the promotion relates to the user's interests." Hoffman also does not teach "a transaction manager component configured to manage" a user's interests, or "select

promotions that relates to the user's inertest," or "a transaction module configured to present information about the one or more selected promotions to the user," as recited in Claim 24.

Moreover, there is no rational for combining the cited references. As the Supreme Court has explained "a patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007). A rational or reason must be provided for combining the reference. *Id.* Furthermore, "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." *See Graham v. John Deere*, 383 U. S. 1, 36 (U.S. 1966). Here, the Examiner does not present any rational for combining the references. The Examiner's reasoning is limited to a statement that "it is simple common sense that the promotion would be chosen to relate to the user's interests." Office Action, page 5. This is clearly based on hindsight biased. Thus, the Examiner has failed to establish a prima facie case of obviousness of Claim 24.

Claims 25-27

Claims 25-27 depend from Claim 24 and thus include all the limitations of Claim 24, as well as other limitations of particular utility. Applicant respectfully submits that Claims 25-27 are patentably distinguished over Hoffman in view of Meyer for the reasons stated above with respect to Claim 24 and because of the additional limitations included in these claims.

Rejection of Claims 24-27 under 35 U.S.C. §112, First Paragraph

The Examiner also rejected Claims 24-27 under 35 U.S.C. § 112 as failing to comply with the written description requirement and failing to provide enablement. With respect to these rejections, Applicant is prepared to make any necessary amendments to Claims 24-27, after the 35 U.S.C. § 102 and § 103 rejections are withdrawn.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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